

## REMARKS

Claims 1-2 and 4-28 are pending in this application. With this response, Claims 1, 6-10, 12, 14 and 16 have been amended, and Claim 3 has been deleted, as further explained below. It is respectfully submitted that all amendments are supported by the specification and claims as filed, and no new matter has been added.

**Rejection Under 35 U.S.C. § 112**

Claim 14 stands rejected as indefinite under 35 U.S.C. § 112 ¶2 concerning the phrase "greater than or equal to C3." Applicant respectfully submits that one skilled in the art would understand the phrase to mean a hydrocarbon residue having 3 (three) or more carbons. Nevertheless, Claim 14 has been amended to recite "a hydrocarbyl residue of three or more carbons." Accordingly, it is respectfully submitted that amended Claim 14 is not indefinite.

**Rejection Under 35 U.S.C. § 102**

Claims 1-2, 4-5, 10, 12 and 14 stand rejected as anticipated by U.S. Patent No. 6,031,019 to Tsutsumi et al. ("Tsutsumi" or "the '019 patent"). Furthermore, Claims 3, 6-9, 11, 15, 17, and 23-25 stand rejected as anticipated by Tsutsumi, when taken with *Dictionary of Science* (John Daintith, Oxford University Press) ("the Daintith reference").

Claim 1 has been amended to exclude unsaturated alpha carbon bearing compounds, thereby removing Tsutsumi as an anticipatory reference. Claim 3 has been deleted, and Claim 7 has been amended to depend from Claim 1 instead of Claim 3. Claims 6, 8, 10, 12, and 15 have been amended in a similar manner, to exclude unsaturated alpha carbon bearing compounds. Additionally, the language directed to "vinylic" carbons has been deleted to address the Daintith reference.

Support for the above-noted amendments can be found in the specification and claims as originally filed. See e.g., specification at page 5, lines 23-27 (indicating that the carboxyl.c,

sulphonic or phosphoric acid part of the silylester is “more preferably, saturated at the alpha carbon.””(emphasis added). Applicant respectfully submits that the anticipation rejections have been addressed and all independent and dependent claims are patentable over the cited art.

**Rejection Under 35 U.S.C. § 103**

Claim 28 stands rejected under 35 U.S.C. § 103(a) over Tsutsumi in view of U.S. Patent No. 4,108,812 to Grueninger, when in combination with U.S. Patent No. 6,284,031 to Healy.

Claim 28 is a dependent claim, which ultimately depends from Claim 8.

As a threshold matter, Applicant respectfully disagrees with Examiner’s characterization of Tsutsumi as a “erodability booster.” See October 15, 2008 Office Action at page 3. Tsutsumi does not disclose erodability *boosting* (*i.e.*, increasing erosion), but rather resistance to erosion -- e.g., water fastness and scratch resistance. See *id.* (citing Tsutsumi at Col. 1, ll. 60-65). In contrast, one purpose of the present invention is to increase erosion so that the anti-fouling composition is gradually released from the paint over time and therefore more effective against marine organisms. See e.g., specification at page 1, ln. 15 - page 2, ln. 11; page 5, ll. 1-6. Accordingly, Tsutsumi teaches away from the present invention, and does not support a rejection based on 35 U.S.C. § 103. See MPEP at 2141.02, subsection VI (“prior art reference must be considered in its entirety ... including portions that would lead away from the claimed invention)(citation omitted). In a similar fashion, the Examiner’s position that Grueninger teaches increasing binding properties of inks indicates that Grueninger does not disclose erodability boosting compositions. See Oct. 15, 2008 Office Action at page 8 (citing Grueninger); *see also* Grueninger at Col. 2, ll. 54-56, Col. 3, ll. 9-11 (indicating that inks have excellent bleed resistance to water). Therefore, one skilled in the art would not look to these references when attempting to develop a paint that demonstrates erosion over time to release an

active agent. Accordingly, Applicant respectfully submits that Claim 28 is patentable over the cited art.

Additionally, as explained above, Claim 8 has been amended, thus removing Tsu sumi as a reference. For at least this additional reason, Claim 28 is patentable over the cited art.

**Claim 9**

Claim 9 has been amended to add the term "acid" after the phrase "monocarboxylic, sulphonic or phosphoric" to conform to the style used throughout the specification and claims. No new matter has been added with this amendment.

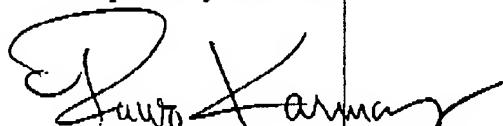
**Rejection for Non-Statutory Obviousness Type Double Patenting**

Claims 1-15 and 17 stand provisionally rejected for non-statutory obviousness-type double patenting over Claims 1, 24, 30, 31, 38, and 39 of co-pending U.S. Patent Application No. 10/520,636 ("the '636 Application"). In view of the claim amendments described above, Applicant respectfully submits that Claims 1-15 and 17 of the present application are patentably distinct over the claims of the '636 Application, which relate to monomers that are unsaturated at the alpha carbon (*i.e.*, alkacryloxy siloxanes). Applicant respectfully requests that the non-statutory obviousness type double patenting be withdrawn.

**CONCLUSION**

Applicant respectfully submits that the application is now in proper form for examination and favorable consideration. The Examiner is invited to contact the undersigned attorney for Applicant to discuss any outstanding issues.

Respectfully submitted,



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